REMARKS

The Examiner rejected: 1) Claim 7 under 35 U.S.C. § 112 2nd ¶ as indefinite; 2) Claims 1 and 3 as obvious under 35 U.S.C. § 103(a) over Jordan et al. (U.S. Patent No. 4,313,035) in view of Pepper (U.S. Patent No. 5,930,700); 3)
5 Claims 2, 5 and 6 as obvious over Jordan in view of Pepper and further in view of Moon (U.S. Patent No. 6,075,992); and 4) Claim 4 as obvious over Jordan in view of Pepper and further in view of Wiedeman (U.S. Patent No. 5,448,623); and 5) Claim 7 as obvious over Jordan in view of Pepper and further in view of Moon and further in view of Wiederman. Applicants traverse the rejections and
10 respectfully request reconsideration.

I.   § 112 Rejections

The Examiner rejected Claim 7 as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner noted that a gateway can't be close to a
15 telephone number. Applicants have amended claim 7 and respectfully submit that the Examiner's § 112 rejection is now moot.

II.   § 103(a) Obviousness Rejections

The Examiner rejected all of the claims as obvious under § 103(a) over
20 various combinations of Jordan and Pepper. Applicants respectfully submit that the Examiner has not made a prima facie case of obviousness. One of ordinary skill in the art would not have been motivated to combine Jordan and Pepper in the manner asserted by the Examiner to arrive at the invention as claimed in claims 1-7. The Examiner has therefore based all of the rejections on improper
25 hindsight analysis.

To meet the burden of prima facie obviousness, the Examiner must put forth evidence to fulfill three criteria: 1) there must be a suggestion or motivation to modify the reference or combine reference teachings, 2) there must be a

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reasonable likelihood of success of the modification or combination, and 3) the prior art references must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In this case, the Examiner has failed to show any suggestion or motivation to make the asserted

5   combination. In addition, the Examiner has also failed to show any reasonable likelihood of success in making the asserted combination.

Neither Jordan nor Pepper contains any suggestion or motivation to make the combination asserted by the Examiner. Jordan is directed to a system that allows a subscriber to indicate whether he or she is available to take telephone

10   calls. *See* Jordan, Col. 3, lines 5-15. If a calling party attempts to reach the subscriber when the subscriber is unavailable, the calling party is alerted as to the subscriber's unavailability and offered the opportunity to key in a special code requesting that the subscriber return the calling party's telephone call. *See* Jordan, Col. 3, lines 22-32. Later, the subscriber may inquire from the data base

15   to determine whether he should return any telephone calls. *See* Jordan, Col. 3, 33-35.

Pepper on the other hand teaches automatically screening calls, faxes, emails, etc. directed to the subscriber. Pepper teaches a system having a database containing call origin priority information, call delivery preferences, and

20   subscriber appointment schedule information such as call delivery addresses...a network interface configured to receive an incoming telephone call to connect the call to the appropriate destination, send the information to a service control module...a service control module to manage the process of incoming calls and determine the appropriate destination of the call...and a user interface for

25   receiving calls and for maintaining schedule and caller priority information from the user. *See* Pepper, col. 3, lines 30-47. The user in Pepper must enter a schedule and a list of clients, and via a PDA, preferences on how to handle an incoming call. *Id.* at lines 48-64.

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Pepper clearly teaches away from Jordan by teaching contrasting solutions to a similar problem-how to handle incoming calls. Jordan teaches allowing a caller to signal a request to the subscriber that the subscriber return his call at the subscriber's leisure when the subscriber is unavailable. Pepper on

5   the other hand teaches configuring a database with preferences as to how incoming calls should be handled using priorities and a connection via a PDA. One of ordinary skill in the art would clearly have been lead away from Pepper in view of Jordan, or away from Jordan in view of Pepper. The two solutions are so distinct, a combination would have been unthinkable to one of ordinary skill in the

10 ar.

In rejecting the claims, the Examiner asserted that:

> One of ordinary skill in the art would have been led to
> make this modification because a display enhances
> the user's interface capabilities and flexibility of user
15 > control, and a wireless network allows subscribers to
> be mobile while using the services.

Office Action, pg. 4.

Applicants respectfully submit that the Examiner has not shown how one

20 of ordinary skill in the art would have been motivated to make the asserted combination. First, the Examiner does not address any need in Jordan that would have been filled by having a display. Moreover, Jordan is directed to a location service that handles the subscriber's communications while unavailable. A wireless network would have permitted a subscriber to be reached anywhere,

25 thereby rendering moot any need for the solution offered by Jordan.

Applicants respectfully submit that Jordan cannot be combined with Pepper in the manner suggested by the Examiner because Jordan and Pepper teach away from each other. Applicants respectfully submit that all of claims 1-7 are allowable. Favorable reconsideration is respectfully requested.

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CONCLUSION

Applicants therefore respectfully submit that all pending claims 1-7 are allowable and request that the rejections to those claims be withdrawn. If any questions or issues remain, the Examiner is invited to contact the undersigned

5 attorney, Enrique Perez, at his direct dial number (312) 913-2104.

Respectfully submitted,

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APPENDIX A

Claims Presently Pending, Including Marked-Up Version of Amended Claims

1. (Amended)   A personal information device (PID) for controlling telephone service comprising:

    a user interface comprising a display and a user input device;

5   a user profile having a telephone number entered by a user;

    a communications function to establish a data communications channel over a wireless network to a telephony control server, the telephony control server containing the user's telephony account; and

10   an account update function to send a message over the data communication channel to the telephony control server, the message containing the user profile telephone number and a request to set the user's telephony account telephone number to the user profile telephone number.

2.   The PID of Claim 1 further comprising:

    a contacts application operable to display a plurality of contact entries, each entry comprising a contact telephone number, the contacts application operable to send the contact telephone

5   number over the data communications channel to the telephony control server with a message to call the contact telephone number.

3.   A telephony control server comprising:

    a network interface operable to provide data connectivity with a user accessible via a wireless network;

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an accounts program to access a plurality of user accounts,
the accounts program operable to receive a message to set a user
telephone number, each user account containing a telephone
number entry, the accounts program being operable to set the
telephone number entry in response to the message;

a connection signaling function to receive a call message
from the user and to establish a telephone connection between the
user telephone number and a callee telephone number contained in
the call message; and

the connection signaling function operable to initiate a
telephone call having at least a portion of the telephone call
connected via the data network.

4. The telephony control server of Claim 3 further comprising:

a gateway locator to locate a user gateway closest to the
user telephone (number) and to locate a callee gateway closest to
the callee telephone (number); wherein the connection signaling
function initiates the portion of the call connected via the data
network between the user gateway and the callee gateway.

5. A method for modifying a user telephone account having a telephone
number entry using a wireless personal information device (PID) connected over
a data network, the method comprising the steps of:

updating a user profile in the wireless PID to a user
telephone number; and

sending a request to set the user telephone account to the
user telephone number over a data communications channel to a
telephony control server wherein the telephony control server

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10   updates the user telephone number entry to the user telephone
      number.

1   6.   A method for initiating a data network telephone call using a wireless PID
2   with a display comprising the steps of:
3   starting a contacts application to display a plurality of contact
4   entries;
5   selecting one of the contact entries identifying a callee;
6   initiating a data communications channel to a telephony
7   control server having a user telephone number;
8   sending a message to call the callee;
9   connecting a telephone call to the user; and
10   connecting the telephone call to the callee.

1   7.   The method of Claim 6 wherein the step of connecting the telephone call
2   to the callee includes the steps of locating a callee gateway closest to the {user
3   telephone number} callee telephone and sending a signal to call the callee by
4   dialing via a callee's central office.

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